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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,644	08/19/2003	Francois J. Henley	018419-000183US	5492
20350	7590	06/24/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LEE, HSIEN MING	
			ART UNIT	PAPER NUMBER
			2823	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

11A

Office Action Summary	Application No. 10/644,644	Applicant(s) HENLEY ET AL.	
	Examiner Hsien-ming Lee	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-65 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 52-65 is/are rejected.
- 7) ☒ Claim(s) 56, 57, 59 and 60 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

HSIEN-MING LEE
PRIMARY EXAMINER

8/22/05

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 012304

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 56,57, 59 and 60 are objected to because of the following informalities as follows.

In re claims 56, 57 and 59, changing “selected from “ into -- selected from a group consisting of -- is suggested. See M.P.E.P. 2173.05 (h).

In re claim 60, the term” transfer material” should be -- transfer substrate --.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 52-57, 59 and 62-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Biasse et al. (US 5,993,677, submitted by applicants).

In re claim 52, Biasse et al teach a method for forming multilayered substrates, comprising:

- providing a donor substrate 110/112 comprising an overlying film of material 112 to be detached (Fig.6B);
- coupling the film of material 112 from the donor substrate 110/112 to a transfer substrate 120 (Fig.6A and Fig.7);
- releasing the film of material 112 from the donor substrate 110/112, while maintaining attachment to the transfer substrate 120 (Fig. 8);

- coupling the film of material 112 on the transfer substrate 120 to a handle substrate 132 (Fig.9); and
- transferring the film of material 112 from the transfer substrate 120 to the handle substrate 132 to free the film of material 112 from the transfer substrate 120 while providing the film of material 112 on the handle substrate 132 (Fig.10).

In re claim 53, Biasse et al teach that the transfer substrate 120 temporarily holds the film of material 112 before the film of material 112 has been released using a controlled cleaving action (col. 3, lines 16-17).

In re claim 54, Biasse et al teach that the transfer substrate 120 couples to the top surface of the film of material 112 (Fig.7).

In re claim 55, Biasse et al teach that the transfer substrate 120 couples to an implanted surface 126 of the film of material 112 (Fig.7 and col. 3, lines 16-19).

In re claim 56, Biasse et al teach that the coupling is provided using adhesive (col. 3, lines 45-51).

In re claims 57 and 59, Biasse et al teach that the transfer substrate 120 is made of a conductive material, i.e. silicon (col. 3, line 24).

In re claim 62, Biasse et al teach that the film of material 112 has been formed using a controlled cleaving action (i.e. forming a gases micro-bubbles zone 126, which would be subjected to the cleaving action, col. 3, lines 18-23 and col. 4, lines 52-54) before the coupling of the film of material 112 on the transfer substrate 120.

In re claim 63, Biasse et al teach that the film of material 112 on the donor substrate 110/112 has been detached via tearing not by removing via etching (col. 4, lines 4, lines 7-10).

In re claim 64, Biasse et al teach subjecting the film of material 112 on the transfer substrate 120 to a first process, i.e. subjecting to a joining process by means of a glue (col. 3, lines 45-51).

In re claim 65, Biasse et al teach subjecting the film of material 112 on the transfer substrate 120 to a second process, i.e. subjecting to an annealing process (col. 3, lines 56-58).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 58, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biasse et al. in view of Takemura et al. (JP 07164728).

In re claim 58, the selection of the material of the transfer substrate is obvious because it is a matter of determining optimum process condition by routine experimentation with a limited number of species. In re Jones, 162 USPQ 224 (CCPA 1955)(the selection of optimum ranges within prior art general conditions is obvious) and In re Boesch, 205 USPQ 215 (CCPA 1980)(discovery of optimum value of result effective variable in a known process is obvious). In this case, one of the ordinary skill in the art would have been motivated to choose a desired material as the transfer substrate, as long as the transfer substrate can be easily detached from the donor substrate during the transferring

In re claims 60-61, Biasse et al. do not teach that the transfer substrate comprises a plastic material.

The selection of the material of the transfer substrate is obvious because it is a matter of determining optimum process condition by routine experimentation with a limited number of species. In re Jones, 162 USPQ 224 (CCPA 1955)(the selection of optimum ranges within prior art general conditions is obvious) and In re Boesch, 205 USPQ 215 (CCPA 1980)(discovery of optimum value of result effective variable in a known process is obvious).

For example, Takemura et al. teach providing a donor substrate 1/2/4/31/32 comprising an overlying film of material 31/32 (Fig.2); coupling the film of material 31/32 from the donor substrate 1/2/4/31/32 to a transfer substrate 7 (Figs.4-5), wherein the transfer substrate 7 comprises a plastic.

Therefore, it would have been obvious to one of the ordinary skill in the art, at the time the invention was made, to utilize the plastic, as taught by Takemura et al., as the transfer substrate in Biasse et al., since the plastic having a flexibility, which can be easily detached from the donor substrate.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hsien-ming Lee whose telephone number is 571-272-1863. The examiner can normally be reached on Tuesday-Thursday (8:00 ~ 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2823

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hsien-ming Lee
Primary Examiner
Art Unit 2823

June 22, 2005

HSIEN-MING LEE
PRIMARY EXAMINER

6/22/05